

Attorney Docket No.: 2870

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shah

Serial No.: 09/248,524

Filed: February 9, 1999

For: Long-Wearing Cosmetic Compositions

Group Art Unit: 1619

Examiner: Berman, Alysia

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on

Date July 12, 2001 Atty's Reg. # 31,145

Atty's Signature

Esther J. Treadwell  
KENYON & KENYON

RESPONSE PURSUANT TO 37 CFR 1.113 & 1.116

The Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

In response to the Examiner's Advisory Action of May 9, 2000 please consider the remarks below which are believed to either place the application in condition for allowance or in better condition for appeal. The remarks provided herein directly respond to the Examiner's comments provided in the Advisory Action, and therefore, could not have been offered in an earlier response. Applicants also request a two month extension of time pursuant to 37 C.F.R. 1.136(a).

In the Advisory Action, Claims 1 to 38 are inadvertently rejected as there are only 22 Claims in the present application. However, these claims are rejected by the Examiner as being unpatentable over Alwattari et al., U.S. Pat. No. 5,874,072 ("the '072 reference") and Valdez et al., U.S. Patent No. 4,761,277 ("the '277 reference"). According to the Examiner, as asserted in the Final Office Action of February 12, 2001, water-soluble organic pigments of the '277 reference can be substituted with the water-insoluble organic pigments of the '072 reference to achieve the present invention. However, Applicants believe that these two types of pigments are not interchangeable when considering the cited references as a whole, and therefore, they do not, alone or in combination, render the present invention obvious.

The present invention relates to long-wearing compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment. The composition is water resistant and does not run or settle into lines and creases on the skin.

#12  
NE  
HKO  
7-23-01

07/18/2001 BNGUYEN1 00000177 051320 09248524  
01 FC:116 390.00 CH

RECEIVED  
JUL 20 2001  
PATENT  
TECH CENTER 1600/2900



The cited references fail to teach or suggest the present invention. The '277 reference teaches water-soluble pigments and a film-forming agent consisting essentially of the combination of polyvinyl pyrrolidone and polyvinyl alcohol in a water base composition, while the '072 reference teaches water-insoluble pigments in the oil-dispersible phase of an emulsion comprising another combination of polymers, namely, water-soluble polymers and water-insoluble film forming polymers which can be acrylates copolymers. None of the water-soluble components of the '277 reference are interchangeable with the water-insoluble components of the '072 reference because anything water-soluble and water-insoluble is considered by one of ordinary skill in the art to be opposites, and to therefore, function in divergent roles. Thus, Applicants further demonstrate that the present invention is non-obvious.

In Applicants' Response of May 14, 2001, Applicants argued that since the '277 reference teaches that oil causes a wick to clog, there is no motivation to put the '277 water-soluble pigments in the '072 compositions which are oil-containing emulsions. Further, the teaching in the '277 reference is directed against and away from such a substitution or combination. In the present Advisory Action of June 12, 2001, the Examiner explains that Applicants' arguments are not commensurate in scope with the independent claims. In particular, the Examiner finds that the '277 reference does not exclude oil from its compositions; but, merely states that oil-based compositions have traditionally caused clogging. Further, according to the Examiner, the '072 compositions are water-based and may contain oil; but, this does not provide patentability to the independent claims.

Applicants have not and do not presently assert that the '277 reference expressly states that oil is excluded from its compositions. However, the '277 reference does teach that the incorporation of oil in its compositions results in adverse effects such as clogging. Further, since the '277 reference does state, as the Examiner acknowledges, that oil-based compositions cause clogging, there is no motivation for incorporating the '277 water-soluble pigments in the '072 compositions, nor would one of ordinary skill in the art expect to successfully make such an exchange. Rather, one skilled in the art would expect the combination to result in clogging problems.

Even though the '072 reference teaches oil as an optional ingredient, Applicants pointed out previously in Applicants' Response of December 5, 2000, at page, 7, lines 3 to 10, and now that in addition to oil, pigments and wax are also optional ingredients in the '072 compositions as taught at column 4, lines 27 to 29, yet these two components are required in claim 1 of the '072 reference. Thus, if one of ordinary skill in the art were to consider exchanging the water-insoluble pigments of the '072 reference with the '277 reference there is one major reason why this would not be done. One of ordinary skill in the art would

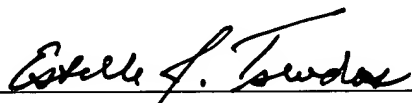
expect wax to cause even more clogging than oil. As previously elaborated upon in Applicants Response of May 14, 2001 and mentioned above, the '277 reference teaches that wax or oil causes clogging and other adverse effects. In addition, the '072 reference teaches at column 5, lines 27 to 30, that wax is similar in composition to fats and oils. Furthermore, the water-insoluble pigments of the '072 reference are incorporated with the oil dispersible components of the '072 compositions. Therefore, the exchange proposed by the Examiner would take the water-soluble pigments out of the compatible water-based '277 compositions and into the incompatible oil or wax of the '072 emulsion. This is exactly what the '277 reference teaches away from and what one of ordinary skill in the art knows would be illogical.

Even if the water-soluble pigments of the '277 reference could be incorporated in the '072 compositions, this combination does not make the present invention which has a single acrylic based polymeric component combined with water-soluble organic pigments. The combination of the '072 and the '277 references is still a combination of water-soluble and water-insoluble polymers in an emulsion and this is not the present invention. The present invention is a composition comprising a simple polymeric component of an acrylic acid derived polymer or copolymer and at least one water-soluble organic pigment, and the benefits derived therefrom are not taught or suggested by the combination of cited references even if the water-soluble pigments of the '277 reference could be substituted for the water-insoluble pigments of the '072 reference.

In view of the arguments presented above in the present submission, the claims are believed to be in condition for allowance because there is no motivation to combine the '072 and the '277 references and because the combination of these cited references fails to teach or suggest the present invention. Therefore, Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a). Accordingly, Applicants request that the rejection under 35 U.S.C. §103(a) be withdrawn and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

Dated: 7/12/01

  
Estelle J. Tsevdos, Reg. No. 31,145  
Kenyon & Kenyon  
One Broadway  
New York, NY 10004  
(212) 425-7200